

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

N0171US

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on _____

Signature _____

Typed or printed name _____

Application Number

10/665,736

Filed

09/17/2003

First Named Inventor

George Filley

Art Unit

2624

Examiner

Sean T. Motsinger

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Lisa M. Schoedel/

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Signature

Lisa M. Schoedel

Typed or printed name

☐ attorney or agent of record.

Registration number _____

312-894-7351

Telephone number

☒ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 53,564

01/22/2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
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9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
GEORGE FILLEY, JAMES HEBST,) Examiner: SEAN T. MOTSINGER
M. SALAHUDDIN KHAN, ROBERT)
GOURDINE, TIMOTHY GIBSON,)
JON SHUTTER, FRANK KOZAK) Group Art Unit: 2624
)
Serial No.: 10/665,736)
) Confirmation No.: 4664
Filing Date: September 17, 2003)
)
For: LOCATION-REFERENCED)
PHOTOGRAPH REPOSITORY)

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Applicants request review of the Office Action mailed October 23, 2008.

1. Status of the Claims

Claims 1-23 and 29-75 are currently pending. The Examiner rejected claims 1-7, 9, 12-23, 29-35, 37, 40-51, and 75 under 35 U.S.C. § 103(a) as being obvious in view of the combination of U.S. Patent No. 6,950,198 ("Berarducci"), U.S. Patent No. 6,914,626 ("Squibbs"), U.S. Patent No. 6,943,825 ("Silvester"), and U.S. Patent No. 7,135,994 ("Kamikawa") ("the first combination"). The Examiner rejected claims 52-58, 60, and 63-74

under 35 U.S.C. § 103(a) as being obvious in view of the combination of Berarducci, Squibbs, Kamikawa, and U.S. Patent Publication No. 2002/0143762 (“Boyd”) (“the second combination”). The remaining dependent claims were rejected under 35 U.S.C. § 103(a) as being obvious in view of one of the first and second combinations and one of U.S. Patent No. 6,977,679 (“Tretter”), U.S. Patent No. 7,100,190 (“Johnson”), and U.S. Patent No. 6,965,828 (“Pollard”).

2. The Claimed Invention

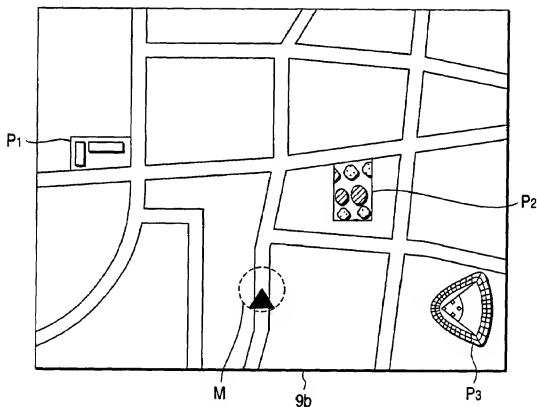
Claims 1, 29, and 52 are independent claims. In claim 1, Applicants recite a method of storing photographs. The method includes providing a data repository on a network accessible to a plurality of users who have digital photographs. The method further includes receiving digital photographs from the users and storing the photographs in the data repository. The method also includes providing a search function and allowing users to select digital photographs stored by other users. In addition, the method includes providing the users with route guidance for traveling to locations shown in the selected digital photographs. Similarly, in claims 29 and 52, Applicants recite “allowing users to select digital photographs stored by other users; and providing the users with route guidance for traveling to locations shown in the selected digital photographs.”

3. Clear Legal Deficiency of Rejections

The Examiner cites to Kamikawa for the teaching of the claim element “*providing the users with route guidance for traveling to locations shown in the selected digital photographs.*” (See, e.g., Office Action, page 5) Kamikawa describes overlaying real images (e.g., satellite photographs and aerial photographs) over a map display. (See, e.g., Kamikawa, Abstract.) For

example, real images of facilities, such as schools and parks, are displayed in areas of a map image corresponding to the facilities. (See, e.g., Kamikawa, col. 8, lines 46-59 and Figure 6 shown below.)

FIG. 6



As a result, a user viewing the display can more easily comprehend the surroundings of the user's current position than when the user is viewing only map images or only photographic images. (See, e.g., Kamikawa, col. 1, lines 17-60.)

Kamikawa does not describe providing route guidance for traveling to a location shown in a photographic image. Instead, Kamikawa describes obtaining and displaying a route based on a vehicle's current position and destination information obtained from a switch signal output

of a joystick or a button switch. (Kamikawa, col. 8, lines 1-12.) Because Kamikawa's photographic images are used to enhance a display, Kamikawa does not suggest providing users with route guidance for traveling to locations shown in Kamikawa's photograph images.

The Examiner stated that "Kamikawa discloses providing rout [sic] guidance for a selected image (column 7 lines 60-67 and column 8 lines 1-10) the image being selected by the users [sic] current position." (Office Action, page 2 (emphasis added).) The Examiner further stated that "Kimikawa is only relied upon for the 'providing' step" and "[w]hile the 'providing' step refers to elements in the previous steps Kimikawa does not have to perform the selection in the same manner as the previous steps." (Advisory Action, Continuation Sheet.)

Applicants believe that the Examiner made a legal error in the Office Action by not considering all the words in the claims. (See, M.P.E.P. § 2143.03.) Specifically, the Examiner did not consider the word "traveling" in the claim element of "providing the users with route guidance for traveling to locations shown in the selected digital photographs." The Examiner stated that Kimikawa teaches providing route guidance to an image selected by the user's current position. However, a user located at his current position does not need route guidance for traveling to his current position. He is already there. By not considering the word "traveling" in the claims, Applicants believe the Examiner made a legal error in the Office Action mailed October 23, 2008.

Applicants also believe that the Examiner's statement that Kimikawa does not have to perform the selection in the same manner as the previous steps is incorrect. Such an interpretation results in the claims covering providing route guidance to a location shown in *any* digital photograph. However, the claims include "allowing users to select digital photographs" followed by "providing the users ... shown in the selected digital photographs." Thus, the

selected digital photographs are the ones that the users are allowed to select. Accordingly, the selection of digital photographs is limited by the claim language. By not considering the word “the” preceding “users” and “selected digital photographs” in the claims, Applicants believe the Examiner made a legal error in the Office Action mailed October 23, 2008.

4. Conclusion

For at least the foregoing reasons, Applicants submit that all of the pending claims should be allowed.

Respectfully submitted,

Date: January 22, 2009

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